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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,404	10/21/2003	Hiroki Moriyama	17136	5953

23389 7590 08/09/2005

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,404

Applicant(s)

MORIYAMA, HIROKI

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/21/03 & 2/20/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: the insertion portion is referred to as having a "soft portion" and also a "soft section". It is recommended the wording be consistent throughout the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3 and 4 claim an endoscope wherein at least part of the tapered portion is located forward an endoscope portion separated 45 cm from the distal endoscope end. Both claims are ultimately dependent from independent claim 1, which claims an endoscope wherein at least part of the tapered portion is disposed forward an endoscope portion separated 70 cm from the distal endoscope end. It is unclear what distance is being claimed, 45 or 70 cm.

Furthermore, claims 7-8, 11-12, and 15-16 are rejected as being dependent from rejected claims 3 and 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3739

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,217,002 to Katsurada et al. in view of U.S. Patent No. 5,916,147 to Boury.

In regards to claim 1, Katsurada et al. disclose an endoscope comprising: an insertion unit having a soft portion 10; a small-diameter portion which is included in the soft section and whose outer diameter is substantially the same over the whole length thereof; a large-diameter portion 2 which is formed on the operator side of the soft section opposite to the small-diameter portion and whose outer diameter is larger than the outer diameter of the small-diameter portion; and a tapered portion linking the small-diameter portion and the large-diameter portion (see Fig. 1) but is silent with respect to at least part of the tapered portion being disposed forward an endoscope portion separated 70 cm from the distal endoscope end. Boury teach of an analogous apparatus for use in endoscopic procedures having an elongate tubular member. Boury teach abdominal and renal catheters are typically on the order of about 50-70 cm. Furthermore, the overall length of the catheter may be varied as necessary (see Col. 4, Lines 5-20). It would have been obvious to one skilled in the art at the time the invention was made to manufacture the apparatus of Katsurada et al. wherein the tapered portion was 70 cm from the distal end of the endoscope in order to allow for an instrument with sufficient length to perform medical procedures within the large intestine as taught by Boury and is well known in the art.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,217,002 to Katsurada et al. in view of U.S. Patent No. 5,916,147 to Boury further in view of U.S. Patent No. 6,899,673 to Ogura et al.

In regards to claim 2, Katsurada et al. and Boury disclose an endoscope having a small diameter portion but are silent with respect to the portion being long enough to be bent 180 degrees while forming an arc having a minimum radius. Ogura et al. teach of an analogous endoscopic device having an inserting portion 11 with a small diameter capable of being bent 180 degrees while forming an arc having a minimum radius (see Figs. 17a-c). It would have been obvious to one skilled in the art the time the invention was made to have the small diameter portion in the apparatus of Katsurada et al. and Boury capable of bending 180 degrees while forming an arc having a minimum radius in order to provide better access to the desired surgical target site as taught by Ogura et al. and is well known in the art.

Claims 5, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,217,002 to Katsurada et al. in view of U.S. Patent No. 5,916,147 to Boury further in view of U.S. Patent No. 5,084,022 to Claude.

In regards to claims 5, 9 and 13, Katsurada et al. and Boury disclose an endoscope but are silent with respect to indices indicating distances from the distal endoscope end are inscribed on the soft-section. Claude teaches of an analogous medical apparatus provided with spaced indicia to indicate the distance the instrument is extended into a vascular vessel, catheter or other instrument (see Figs. 1-3). Furthermore the indices are capable of being formed on the instrument in any desired

Art Unit: 3739

location considered to be helpful to the operator and the desired procedure. It would have been obvious to one skilled in the art at the time the invention was made to include indices on the endoscope of Katsurada et al. and Boury in order to facilitate the determination of the distance an instrument extends into a cavity as taught by Claude.

Claim 6, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,217,002 to Katsurada et al. in view of U.S. Patent No. 5,916,147 to Boury further in view of U.S. Patent No. 6,899,673 to Ogura et al. further in view of U.S. Patent No. 5,084,022 to Claude.

In regards to claims 6, 10 and 14, Katsurada et al., Boury and Ogura et al. disclose an endoscope but are silent with respect to indices indicating distances from the distal endoscope end are inscribed on the soft-section. Claude teaches of an analogous medical apparatus provided with spaced indicia to indicate the distance the instrument is extended into a vascular vessel, catheter or other instrument (see Figs. 1-3). Furthermore the indices are capable of being formed on the instrument in any desired location considered to be helpful to the operator and the desired procedure. It would have been obvious to one skilled in the art at the time the invention was made to include indices on the endoscope of Katsurada et al., Boury and Ogura et al in order to facilitate the determination of the distance an instrument extends into a cavity as taught by Claude.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3739

US 5083549 A to Cho; George E. et al.

US 6613002 B1 to Clark; Tamisha A. et al.

US 5611778 A to Brinon; Thierry

US 4685449 A to Bonnet; Ludwig

US 4690175 A to Ouchi; Teruo et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK *mk*

8/1/05


BEVERLY M. FLANAGAN
PRIMARY EXAMINER